APPENDIX A

IN THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

No. 74-2024

DUNLOP HOLDINGS LIMITED, *Plaintiff-Appellant,*

v.

RAM GOLF CORPORATION, *Defendant-Appellee.*

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division
No. 72 C 2318
JAMES B. PARSONS, *Judge*

ARGUED APRIL 14, 1975—DECIDED OCTOBER 20, 1975

Before CASTLE, *Senior Circuit Judge* and STEVENS and SPRECHER, *Circuit Judges.*

STEVENS, *Circuit Judge.* Plaintiff sued Ram for infringement of its patent covering an unusually durable golf ball.[1] Ram convinced the district court that the patent was invalid because the invention had been made by a third party named "Butch" Wagner. Ram proved that Wagner had publicly used the new golf ball before February 10, 1965, the earliest date that plaintiff can

[1] U.S. Patent No. 3,454,280 covering "Golf Balls Having Covers of Ethylene—Unsaturated Monocarboxylic Acid Copolymer Compositions," issued to Dunlop Rubber Company, Limited, a British company, as the assignee of the two individual inventors, pursuant to a U.S. Patent Application filed February 2, 1966, and a British application filed on February 10, 1965.

claim invention;[2] however, Wagner had not disclosed his formula to the public. The questions on appeal are (1) whether the district court's findings on the prior invention issued are supported by the record, and (2) whether the nondisclosure of the method of making an article which is in public use is the kind of concealment or suppression that avoids the bar to patentability in § 102(g).[3]

The patent covers the discovery that certain synthetic materials,[4] when fabricated by themselves (or with minor amounts of compatible materials), produce a golf ball cover with exceptional cutting resistance. An example of the material described in the patent is a duPont product named 'Surlyn.'' Golf balls made of Surlyn, with or with-

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[2] 35 U.S.C. § 104 provides in part that ". . . an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title." 35 U.S.C. § 119 allows priority from the date of filing in certain foreign countries including Great Britain. Plaintiff is thus barred from establishing a date of invention by reference to its activities in Britain prior to February 10, 1965, the date of its British application.

[3] 35 U.S.C. § 102 provides:

> "A person shall be entitled to a patent unless—
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> "(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it . . . ."

[4] The parties use the term "copolymers" which we understand to refer to a kind of synthetic rubber or plastic material. The description in the patent is of

> "A golf ball comprising a core and a cover, said cover being formed of a composition comprising a copolymer of ethylene and at least one unsaturated monocarboxylic acid containing from three to eight carbon atoms, said copolymer containing up to thirty percent by weight of said acid." Patent No. 3,454,280 column 6, lines 45-50.

out minor additives, infringe the claims in plaintiff's patent.

As noted, the date of invention claimed by plaintiff is February 10, 1965. In April of 1964, duPont was trying to find a commercial use for its Surlyn, a recently developed product. Shortly thereafter, Butch Wagner, who was in the business of selling re-covered golf balls, began to experiment with Surlyn as a golf ball cover. He first made some sample balls by hand and then, using a one-iron, determined that the material was almost impossible to cut. He obtained more Surlyn and made several dozen experimental balls, trying different combinations of additives to achieve the proper weight, color, and a texture that could easily be released from an injection molding machine. By November 5, 1964, he had developed a formula which he considered suitable for commercial production and had decided to sell Surlyn covered balls in large quantities. The date is established by a memorandum recording his formula, which Wagner wrote in his own hand and gave to his daughter for safekeeping on the occasion of her son's birthday.[5]

During the fall of 1964, Wagner provided friends and potential customers with Surlyn covered golf balls. By the end of the year he had purchased enough Surlyn to produce more than 20,000 balls, and by February of 1965 he had received orders for over 1,000 dozen Surlyn covered balls. By the end of 1965, he had ordered enough

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[5] In the district court's original findings this handwritten memorandum was erroneously described as a page in Wagner's formula book, whereas it was actually a separate sheet of paper. We attach no significance to this error, which the district judge subsequently corrected, since the testimony unequivocally established the genuineness of the document. We also find no substance in appellant's objection to the district court's making this minor correction in its findings after the notice of appeal was filed. See Fed. R. Civ. P. 60(a).

Surlyn to produce more than 900,000 such balls. Without commenting further on the evidence, we note our conclusion that there is ample support in the record for the district court's findings that Wagner had discovered the use of Surlyn as a golf ball cover before November 5, 1964, had reduced the discovery to practice before February of 1965, and did not abandon the invention before his death in October of 1965.

We recognize that Wagner continued to experiment with different formulae after his decision to go into commercial production and that he encountered some problems with cracked covers. These facts do not undermine any of the district court's findings on the prior invention issue. The patent claims are broad enough to encompass any golf ball cover made principally of Surlyn, and there is no doubt that Wagner had made a large number of such golf balls and successfully placed them in public use.[6] The only novel feature of this case arises from the fact that Wagner was careful not to disclose to the public the ingredient that made his golf ball so tough.[7] For that

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[6] The evidence identifies at least three golfers who used Surlyn covered balls during the fall of 1964 for rounds of golf played at Riveria Country Club in Los Angeles. (Tr. 366-377; Fredericks Deposition, pp. 4-9; Keller Deposition, pp. 5-11) By February, 1965, two of these golfers, both of whom were favorably impressed with the play of the new ball, had placed orders with Wagner for more than 1000 dozen Surlyn covered balls; they began to distribute them commercially although they both lacked knowledge of the Surlyn content in the cover construction. (Tr. 365-377; Keller Deposition, pp. 5-11; DX 7, 8, 13, and 24-27.)

[7] In support of its contention that Wagner concealed his invention plaintiff relies on (1) the deposition of an acknowledged expert on golf ball construction who failed to discover the Surlyn content of the cover in an analysis of Wagner's ball; and (2) the secretive manner in which Wagner gave the Surlyn formula to his daughter on her son's birthday "to keep in case something ever happened to him." (Brickner Deposition, Vol. II, pp. 106-107.)

reason plaintiff argues that he "suppressed or concealed" the invention within the meaning of § 102(g).

Since 1850 it has been settled that a patentee may be entitled to credit for making a new discovery or invention even though someone else actually made the discovery before he did. *Gayler* v. *Wilder*, 51 U.S. 477. That case established the proposition that an abandoned invention will not defeat the patentability of the rediscovery of "lost art"[8] The case has also been cited for the proposition that an inventor who had merely made a secret use of his discovery should not be regarded as the first inventor. *Gilman* v. *Stearn*, 114 F.2d 28, 31 (2d Cir. 1940).

Gilman involved a patent on a machine which had previously been developed by a man named Haas; Haas had used the machine in his own factory under tight security. The output from the machine had been sold, but the public had not been given access to the machine itself. In holding that Haas was not the first inventor, Judge Hand drew a distinction between a secret use and a noninforming public use.[9] There had been only a secret

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[8] "So, too, as to the lost arts. It is well known that centuries ago discoveries were made in certain arts the fruits of which have come down to us, but the means by which the work was accomplished are at this day unknown. The knowledge has been lost for ages. Yet it would hardly be doubted, if any one now discovered an art thus lost, and it was a useful improvement, that, upon a fair construction of the act of Congress, he would be entitled to a patent. Yet he would not literally be the first and original inventor. But he would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention." 51 U.S. at 497.

See *Marconi Wireless Co.* v. *United States*, 320 U.S. 1, 35.

[9] "We are to distinguish between a public user which does not inform the art (Hall v. Macneale, 107 U.S. 90, 97, 2 S.Ct. 73, 27 L.Ed. 367) and a secret user; . . . ." 114 F.2d at 31.

use of the Haas machine and therefore he was not regarded as the first inventor.

This case certainly involves neither abandonment nor a mere secret use. For the evidence clearly demonstrates that Wagner endeavored to market his golf balls as promptly and effectively as possible. The balls themselves were in wide public use. Therefore, at best, the evidence establishes a noninforming public use of the subject matter of the invention.

If Wagner had applied for a patent more than a year after commencing the public distribution of Surlyn covered golf balls, his application would have been barred notwithstanding the noninforming character of the public use or sale. *Egbert* v. *Lippmann*, 104 U.S. 333, 336;[10] *Magnetics, Inc.* v. *Arnold Engineering Co.*, 438 F.2d 72, 74 (7th Cir. 1971). For an inventor must exercise reasonable diligence if he is to be rewarded with patent protection.[11]

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[10] "An invention may consist of a lever or spring, hidden in the running gear of a watch, or of a rachet, shaft, or cog-wheel covered from view in the recesses of a machine for spinning or weaving. Nevertheless, if its inventor sells a machine of which his invention forms a part, and allows it to be used without restriction of any kind, the use is a public one."

[11] The second sentence of § 102(g) reads as follows:

"In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

A conclusion that Wagner had concealed or suppressed his invention would have to be supported by a stronger showing than a mere lack of diligence. For it is less serious to hold that the first inventor has forfeited his right to a patent monopoly than it is to hold that he has forfeited any right to use his own invention without the permission of a subsequent inventor.

"But we must bear in mind that it was not alone to reward the inventor that the patent monopoly was granted. The pub-

The question of diligence is especially significant in cases arising out of a dispute between two applicants for a patent on the same discovery. For in such a case, when the issue is which of the two applicants is entitled to the monopoly reward, it is often appropriate to weigh the later inventor's diligence in enabling the public to obtain the benefit of the concept more heavily than the earlier date of unexploited conception. *Cf. Mason* v. *Hepburn*, 13 App. D.C. 86, 91 (1898). But in this case, although Wagner may have failed diligently to establish his own right to a patent, there was no lack of diligence in his attempt to make the benefits of his discovery available to the public. In view of his public use of the invention, albeit noninforming, we do not believe he concealed or suppressed the discovery within the meaning of § 102(g).

We recognize, as appellant argues, that portions of Judge Rich's opinion in *Palmer* v. *Dudzik*, 481 F.2d 1377 (C.C.P.A. 1973), suggests that a public use which does not disclose the inventive concept may amount to concealment within § 102(g). But that case, like *Gilman*, involved a patent on a machine; the benefits of using the machine were not made available to anyone except the inventor. Moreover, the case arose out of an interference proceeding in which the dispute was between two applicants for a patent, the earlier of the two having been less diligent than the later. In this case, Wagner was not only the first inventor, but also "the first to confer on the public the benefit of the invention," *Gayler* v. *Wilder*, 51 U.S. at 497.

There are three reasons why it is appropriate to conclude that a public use of an invention forecloses a finding of suppression or concealment even though the use does

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lic was to get its reward and have the advantage of the inventor's discovery as early as was reasonably possible. See Robinson on Patents, § 385." *Hull* v. *Davenport*, 90 F.2d 103, 105 (C.C.P.A. 1937).

not disclose the discovery. First, even such a use gives the public the benefit of the invention. If the new idea is permitted to have its impact in the marketplace, and thus to "promote the progress of science and useful arts,"[12] it surely has not been suppressed in an economic sense. Second, even though there may be no explicit disclosure of the inventive concept, when the article itself is freely accessible to the public at large, it is fair to presume that its secret will be uncovered by potential competitors long before the time when a patent would have expired if the inventor had made a timely application and disclosure to the Patent Office.[13] Third, the inventor is under no duty to apply for a patent; he is free to contribute his idea to the public, either voluntarily by an express disclosure, or involuntarily by a noninforming public use. In either case, although he may forfeit his entitlement to monopoly protection, it would be unjust to hold that such an election should impair his right to continue diligent efforts to market the product of his own invention.

We hold that the public use of Wagner's golf balls forecloses a finding of suppression of concealment; that holding is consistent with both the decided cases and the underlying purposes of the statute.

AFFIRMED.

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Clerk of the United States Court of Appeals for the Seventh Circuit

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[12] U.S. Const., Art. I, § 8, clause 8.

[13] In this case, for example, it is not unreasonable to assume that competing manufacturers of golf balls in search of a tough new material to be used as a cover, might make inquiries of Wagner's Surlyn supplier that would soon reveal his secret ingredient. After all, duPont certainly had a motive to expand the market for Surlyn.

APPENDIX B

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

No. 72 C 2318

DUNLOP HOLDINGS LIMITED, *Plaintiff*,

v.

RAM GOLF CORPORATION, *Defendant*.

MEMORANDUM OPINION AND ORDER

The plaintiff, hereinafter Dunlop, had charged the defendant, hereinafter Ram, with infringement of Dunlop's U. S. Patent No. 3,454,280. Earlier, I ordered a separate trial on the issues raised by Ram's three principal defenses; that separate trial having been completed and post-trial briefs having been submitted, I am now prepared to rule on those issues.

I.

Ram's three principal defenses all attack the validity of Dunlop's patent and thereby propose that the Court is without the power to grant the requested relief. Defendant's assertion of patent invalidity rests on Section 102 of the Patent Act which states, in part, as follows:

> "A person shall be entitled to a patent unless—(b) the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
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> * * * * *
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> (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it . . ."
> 35 U.S.C. § 102.

Specifically, the defendant claims that the invention was "in public use" and "on sale" in this country more than one year prior to February 2, 1965 and that the invention was made by another—a certain 'Butch' Wagner—who had not "abandoned, suppressed or concealed it" prior to February 10, 1965. The invention in question, which is the subject of Dunlop's patent, is a Surlyn-covered golf ball which has now been widely adopted by this country's golf ball industry.

II.

The law is clear that the defendant assumed heavy burdens of proof when it asserted the defenses of prior public use, *Tucker Aluminum Products, Inc.* v. *Grossman*, 312 F.2d 293 (9th Cir. 1963), *The Barbed Wire Patent*, 143 U.S. 275, 12 S.Ct. 443 (1892), *Arnel Industries Inc.* v. *Aerosol Research Co.*, 311 F.Supp. 924 (N.D. Ill. 1969), *Henry J. Kaiser Co.* v. *McLouth Steel Corp.*, 257 F.Supp. 372 (E.D. Mich. 1966); of prior sale, *Arnel Industries supra, Amerio Contract Plate Freezers, Inc.* v. *Belt-Ice Corporation*, 316 F.2d 459 (9th Cir. 1963), *Cataphote Corp.* v. *DeSoto Chemical Coatings, Inc.*, 235 F.Supp. 931 (N.D. Calif. 1964); and of prior invention, *A. J. Industries, Inc.* v. *Dayton Steel Foundry Co.*, 394 F.2d 357 (6th Cir. 1968), *Arnel Industries, supra, Copease Mfg. Co.* v. *American Photocopy Equipment Co.*, 298 F.2d 772 (7th Cir. 1961), *Potter Instrument Co., Inc.* v. *Odec Computer System, Inc.*, 370 F.Supp. 198 (D.R.I. 1974). The plaintiff has argued that the burdens have not been met, and thus that all the defenses should be rejected by the Court. The burdens may be particularly heavy since they are borne by a non-patentee. *Rex Chainbelt, Inc.* v. *Borg-Warner Corp.*, 477 F.2d 481, 491 (7th Cir. 1973). Dunlop asserts (1) the witnesses produced by Ram regarding Butch Wagner's activities were biased; (2) the decision in *The Barbed Wire Patent, supra,* precludes reliance by this Court on solely oral testimony to establish the three defenses; and (3) the record as a whole fails to support Ram's

position with respect to any one of its three defenses. In considering the defenses raised by Ram as well as the arguments asserted by Dunlop, it must be remembered that all duly-recorded patents have a presumption of validity, and any invalidation should come only after the presentation of clear and cogent evidence. 35 U.S.C. § 282; *Radio Corp. of America* v. *Radio Engineering Laboratories*, 293 U.S. 1 (1934); and *Helms Products* v. *Lake Shore Mfg. Co.* 227 F.2d 677 (7th Cir. 1955).

III.

With respect to the plaintiff's charges of bias, the fact that many of Ram's witnesses at trial may have been or may presently be engaged in making, selling or otherwise using Surlyn-covered golf balls must of course be considered by the Court in weighing the credibility of their testimony. Such statements as were made by Ram's witness Bob Wagner concerning possibile financial interests must be weighed very carefully. The presumption is that the Court in this case is in an especially good position to consider such statements since some of Ram's evidence came in the form of oral testimony during which the witnesses' demeanor was closely observed and their testimony subjected to rigorous cross-examination. In this case even the deposition witnesses were thoroughly cross-examined. Contrary to Dunlop's contentions, there was a great deal of documentary evidence presented by Ram which served to substantiate much of the oral testimony of its witnesses. It is true, however, that some of oral testimony can never be so substantiated.

I am of the opinion that the oral testimony of Ram's witnesses was not as biased as has been propsed by *Dunlop*. Of course, some of the testimony concerned events which occurred quite some time ago; but this factor goes to the matter of its evidentiary value. I observe that Ram sought to meet its heavy burden of proof with both substantial

documentary and oral evidence, and not, as Dunlop argues, with simply "oral testimony of biased witnesses."

IV.

With respect to Dunlop's argument that *The Barbed Wire Patent* case, *supra*, precludes reliance on solely oral testimony for the establishment of the three asserted defenses, I already have indicated that I have found substantial documentary evidence in the record on the issues of prior public use, prior sale and prior invention. This is not to say, however, that I am unaware of the "temptation to actual prejury," the "eagerness of interested parties to elicit testimony favorable to themselves," and the possibility that Dunlop has been "treated as the lawful prey" by Ram. *The Barbed Wire Patent* case, *supra*.

V.

Because of the nature of this case, the question resolves itself into whether or not Ram has met its burden of proof on any one of its three asserted defenses. Let me begin by reviewing the evidence that has been put forth on behalf of the prior invention defense, 35 U.S.C. 102(g). To establish the prior invention defense in this case, the defendant must have shown that before February 10, 1965, Butch Wagner made the same invention which is the subject of Dunlop's patent and did not abandon, suppress or conceal that invention. Although the defense of prior invention most commonly applies to priority disputes in interference proceedings, is also may be an appropriate defense in an infringement suit in which a patent application was never filed by the alleged prior inventor. *International Glass Co.* v. *U.S.*, 408 F.2d 395, 403 (Ct.Cl. 1969) and *Engelhardt* v. *Judd*, 369 F.2d 408, 411 (C.C.P.A. 1966).

As I have used the term and as it is employed in the statutes, an invention comprises both a conception and a

reduction to practice. *Symington Co.* v. *National Castings Co.*, 250 U.S. 383, 386 (1919); *U.S.* v. *Dubilier Condenser Corp.*, 280 U.S. 178, 188 (1933); *Jamesburg Corp* v. *Worcester Valve Co.*, 318 F. Supp. 1 (D. Mass. 1970), *affirmed* 443 F.2d 205 (1st Cir. 1971); *Spero* v. *Ringold*, 377 F.2d 652, 660 (C.C.P.A. 1967). Conception of an invention is a mental act, known only to its originator. It must be proven by evidence showing what the inventor has disclosed to others and what the disclosure meant to one of ordinary skill in the art. *Spero, supra*, 377 F.2d at 660; *Schmierer* v. *Newton*, 397 F.2d 1010, 1015 (C.C.P.A. 1968); *Boyce* v. *Anderson*, 451 F.2d 818 (9th Cir. 1971). "The conception of the invention consists in the complete performance of the mental part of the inventive act." *Townsend* v. *Smith*, 36 F.2d 292, 295 (C.C.P.A. 1929), cited with approval in *spero, supra*. Reduction to practice, on the other hand, is proven when "there is corroborated testimony that the device actually performed the function for which is was designed," *Schnick* v. *Fenn*, 277 F.2d 935, 940 (C.C.P.A. 1960), cited with approval in *Potter Instrument Co., Inc., supra*, and *Farrand Optical Co.* v. *U.S.*, 325 F.2d 328 (2nd Cir. 1963). See also *Boyce, supra*. Reduction to practice may be shown even though the device is not quite in shape to be commercially marketable. *Radio Corp. of America* v. *International Standard Electric Corp.*, 232 F.2d 726, 730 (3rd Cir. 1956) cited with approval in *Potter Instrument Co., Inc., supra*.

As I have used the terms and as they are employed in the statutes, "abandon, suppress or conceal" mean that even though an invention may be completed, no steps have been taken to make the invention publicly known, *International Glass Co., supra*, 408 F.2d at 403, and there is no reasonable explanation for the delay, *Young* v. *Dworkin*, 489 F.2d 1277, 1281 (C.C.P.A. 1974). See also *Layne-New York Co., Inc.* v. *Allied Asphalt Co., Inc.*, 363 F. Supp. 299, 305 (W.D. Pa. 1973).

Because of the aforementioned burden of proof on Ram relating to its defense of prior invention, the evidence on

Butch Wagner's conception of the notion of a Surlyn-covered golf ball and on his reduction of that conception must be "clear, satisfactory, and beyond a reasonable doubt." *The Barbed Wire Patent* case, *supra.* Although I recognize that there exist differences of opinion on the precise nature of the reasonable doubt standard in patent cases, I am of the opinion that the defendant's position in this case on the defense of prior invention has been so firmly established that is is unnecessary for me to consider the differing viewpoints. *Potter Instrument Co., Inc., supra,* 370 F. Supp. at 205.

VI.

After reviewing the entire record, I am of the opinion that Butch Wagner made the same invention, which is the subject of Dunlop's Patent No. 3,454,280, prior to February 10, 1965, and that he did not abandon, suppress or conceal it. To support this opinion, I recite the following crucial facts I find from the evidence:

1. By the early part of 1950, Butch Wagner—while President of the Metropolitan Golf Ball Company—himself had begun to experiment with the use of polyethylene as a golf ball cover material. At this time, Metropolitan was still located in Chicago. (Tr. 38, 45-46.)

2. After Metropolitan moved from Chicago to Santa Monica, California, later in 1950, Butch Wagner continued to experiment with and produce golf balls with polyethylene covers, utilizing the help of various employees of Mercury Plastics Company. (Tr. 45-46, 48-50, 58-59; Rhodes dep., 38.)

3. During the course of his experimentation with and production of golf balls after 1950, Butch Wagner maintained a so-called "Formula Book" in which he kept a record of the various mixtures or formulas

which he had used, together with a record of the results of their use. (Tr. 62-63.)

4. As of April, 1964, Surlyn was a new material which had recently been developed by the E. I. du Pont de Nemours Company, samples of which were distributed at that time with the purpose of finding commercial uses for the new material. (DX 20, 22; Kinsey dep., 291-294.)

5. The records of the du Pont company reveal that as early as April, 1964, at least 1,000 pounds of Surlyn A were shipped to du Pont's Los Angles warehouse. (DX 20.)

6. Within a short time after the Surlyn A was shipped to Los Angles, Butch Wagner obtained samples of the new material from William Rhodes of Mercury Plastics who himself obtained Surlyn A from the du Pont company. (Tr. 67, 71-72; Rhodes dep., 49-50.)

7. Shortly after obtaining samples of Surlyn A, Butch Wagner used it in his experimentation and production of golf ball covers. (Tr. 71; Rhodes dep., 50-51.)

8. After having successfully experimented with Surlyn A, Butch Wagner immediately sought to obtain large quanities of Surlyn A and did obtain such from William Rhodes. (Tr. 72-73, 76-77; Rhodes dep., 51.)

9. Upon receiving more Surlyn A, Butch Wagner—among others associated with him—further experimented with and produced golf balls covered with Surlyn A. (Tr. 74-76.)

10. The golf balls made with Surlyn A by Butch Wagner and the Metropolitan Golf Ball Company at this time—in mid 1964—contained different mixtures or formulation of materials, in that the amount of

Surlyn A and of other substances varied. (Tr. 75-76.)

11. The results of the various tests that were made on these new golf balls in mid 1964, including the test of actually playing golf with the new balls, encouraged Butch Wagner to further experiment and produce. (Tr. 76-77.)

12. The specific dates when these golf balls were made do not appear in Butch Wagner's formula book, though the various mixtures or formulations do appear therein. (DX 2.)

13. By September, 1964, 27 pounds of Surlyn half covers were produced by Mercury Plastics, resulting in the production of about 1,000 Surlyn-covered golf balls by Butch Wagner and associates. (Tr. 79-82 and 86; DX 5-6; Elliott's dep., 18-22.)

14. Some of these 1,000 surlyn-covered golf balls were placed on a certain outdoor driving range for testing, some were placed in a certain indoor golf school's driving range, some were given away by Butch and Bob Wagner, some were sold, some were played, and some were given away by William Rhodes. (Tr. 80-81, 111-113, 366-367; Rhodes dep. 57-58; Fredericks dep., 4-9; Keller dep., 5-11; DX 16.)

15. Butch Wagner recorded a formula for Surlyn-covered golf balls in his formula book on November 5, 1964. (DX 3; Tr. 82; Brickner dep., Vol. II, 106-107.)

16. The formula recorded on November 5, 1964 was one which Butch Wagner, together with his son Bob Wagner and his daughter Madalyn Brickner, decided to use in the commercial production of Surlyn-covered golf balls. (Tr. 83; Brickner dep., Vol. II,

62.) And that decision was made sometime in early November, 1964. (Tr. 83, 85-86; Brickner dep., Vol. II, 45 and 62; DX 1 and 17; Rhodes dep., 29-30, 62-63.)

17. Butch Wagner knew at the time he recorded the formula shown in DX 3, or very shortly thereafter, that the desirable properties of the golf balls produced pursuant to that formula were attributable to the use of Surlyn. (Tr. 84, 216-217; DX 1 and 17.)

18. After this decision was made to commercially produce Surlyn-covered golf balls and prior to February, 1965, at least two separate individuals placed large orders for these golf balls with Butch Wagner. (Tr. 365-371; Keller dep., 8-10; DX 7.)

19. After the decision was made to commercially produce Surlyn-covered golf balls and prior to February, 1965, at least one small order was placed with Metropolitan for the Surlyn balls and was met. (Tr. 112-113; Fredericks dep., 16-20, 28.)

20. Prior to February, 1965, some of the Surlyn-covered golf balls produced, in part, by Butch Wagner were used by several individuals at several different golf-playing areas. (Keller dep., 7-9; Fredericks dep., 6-9; Tr. 76-77, 107.)

21. A large part of the Surlyn-covered golf balls which were produced under the direction of Butch Wagner prior to February, 1965, constituted the same invention as was described by Dunlop in Patent No. 3,454,280. (PTX 1; Kinsey dep., 104-114, 349-354; PTX 19.)

22. The Surlyn-covered golf balls which were produced prior to February, 1965, exhibited the characteristics for which they were designed, including excellent

cutting resistance. (Tr. 76-77, 366; Fredericks dep., 6-9; Keller dep., 6-7.)

23. The Surlyn-covered golf balls which Butch Wagner helped to produce prior to February, 1965, were publicly known prior to February, 1965. (Tr. 76-77, 107, 112-113, 365-371; Keller dep., 8-10; Fredericks dep., 6-9, 16-20, 28.)

In light of these and other facts brought out at trial, Ram's defense of prior invention under 35 U.S.C. § 102(g) has been established, and Dunlop's Patent No. 3,454,280 therefore must be found to be void. The Court here need not establish the actual conception date of the invention in question, for it is clear that the latest possible date is November 5, 1964—a few months before Dunlop's application for a patent was filed. Nor does the Court need to establish the exact first date on which the invention in question was reduced to practice, for it is also clear that this date preceded February, 1965. Even if the reduction to practice date were found to follow the date of Dunlop's application. Dunlop's patent would under the circumstances still be found to be void. *Schmierer, supra,* 397 F.2d at 1019; *Rex Chainbelt, Inc., supra,* 477 F.2d at 487.

Having found the required conception and reduction to practice under § 102(g), I also note that the aforementioned factual findings—together with the remainder of the record—establish that Butch Wagner appreciated the nature of his invention. See, for example, *Langer* v. *Kaufman,* 465 F.2d 915, 920 (C.C.P.A. 1972). The record further establishes that the tests made of Butch Wagner's Surlyn-covered golf balls in late 1964 were "adequate to establish utility in the functional setting of the invention." *Elliott* v. *Barker,* 481 F.2d 1337, 1340 (C.C.P.A. 1973); *Potter Instrument Co., Inc., supra.*

"The courts have consistently held that an invention, though completed, is deemed abandoned, suppressed or

concealed if, within a reasonable time after completion, no steps are taken to make the invention publicly known." *International Glass Co., supra,* 408 F.2d at 403. I am of the opinion that the record in this case clearly establishes that the invention in question was publicly known prior to February, 1965. For example, see Tr. 113-114 and Fredericks dep., 6-7. The record further shows that Butch Wagner's Surlyn-covered golf balls were actually used by some individuals prior to February, 1965, and were planned for commercial production prior to February, 1965. Thus, there was no suppression of the invention. *International Glass Co., supra; Allinson Mfg. Co.* v. *Ideal Filter Co.,* 21 F.2d 22, 27 (8th Cir. 1927). See also *Dewey* v. *Lawton,* 347 F.2d 629 (C.C.P.A. 1965).

Support for this Court's position with respect to Butch Wagner's non-suppression of Surlyn-covered golf balls, at least by late 1964, can also be found by analogy from the concept of "public use" under 15 U.S.C. § 102(b). Butch Wagner's Surlyn-covered golf balls were certainly in public use by late 1964. *Electric Battery Co.* v. *Shimadzu,* 307 U.S. 5, 20 (1938); *Cali* v. *Eastern Airlines, Inc.,* 442 F. 2d 65, 70 (2nd Cir. 1971); *Magnetics, Inc.* v. *Arnold Engineering Co.,* 438 F.2d 72, 74 (7th Cir. 1971). Late 1964 is crucial because Butch Wagner used the concept of Surlyn covered golf balls by then "with a predominantly commercial intent, rather than with the primary purpose of determining whether or in what form the idea should be put into general use." *Cali, supra,* 442 F.2d at 71.

VII.

Having determined Dunlop's patent to be void under 15 U.S.C. § 102(g), there is no need for one to review Ram's defenses of "public use" and "on sale" brought pursuant to 15 U.S.C. § 102(b).

The foregoing opinion is adopted as the Court's findings of fact and conclusions of law in accordance with Rule

52(a) of the Federal Rules of Civil Procedure. Leave is granted to the defendant to file, as it sees fit, any proposed additional finding of fact or other proposed amendments, if any, to this opinion within ten (10) days. Rule 52(b) of the Federal Rules of Civil Procedure.

ENTER:

/s/ JAMES B. PARSONS
James B. Parsons
United States District Judge

Date: November 8, 1974

APPENDIX C

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

Name of Presiding Judge, Honorable James B. Parsons
Cause No. 72 C 2318 Date November 18, 1974

Title of Cause—Dunlop Holdings Limited v. Ram Golf Corporation

Brief Statement of Motion—Motion to correct memorandum opinion and order

Names and Addresses of moving counsel—
Theodore R. Scott
135 South La Salle Street
346-0338

Representing—Defendant

Names and Addresses of other counsel entitled to notice and names of parties they represent—Robert D. Weist, Two First National Plaza, Chicago, Illinois 60603.

On the motion of the defendant, it is ordered that the memorandum opinion and order heretofore entered on November 8, 1974 be and the same hereby is corrected to read as follows: Paragraph 15 on Page 7: "Butch Wagner recorded a formula for surlyn-covered golf balls and gave it to his daughter, Madalyn Brickner, for safe keeping on November 5, 1964. (DX 3; Tr. 82; Brickner dep., Vol. II, 106-107)." First unnumber Paragraph on Page 8, insert "British" before "Patent" in line 7.

JBP/

APPENDIX D

DRAMATIS PERSONAE.

For the possibly greater convenience of this Court when reading the opinions of the lower courts, the various witnesses who gave testimony in this case are as follows:

Three witnesses testified in open court, viz:

HANSBERGER, JAMES R.—Ram's Vice President of Marketing.

WAGNER, ROBERT B., SR.—Butch's son. Affiliated at various times with both Metropolitan Golf Ball Co. ("Metropolitan") and Western Golf Sales as officer.

WITTEK, KLEM—President (and later, Chairman of the Board) of Wittek Golf Range Supply Company of Chicago.

The following witnesses testified by deposition only:

BAHR, DONALD R.—Patent and Trademark Counsel for Questor Corporation, of which Spaulding is an operating division.

BRICKNER, MADALYN—Formerly Madalyn Conway. Butch's daughter. Officer of Golden State Distributors and of Metropolitan.

ELLIOTT, L. STUART—Formerly Vice President and General Manager of Mercury Plastics ("Mercury"), a concern that did custom molding for Butch.

FREDERICKS, DR. J. WYNN—Retired Director of the Department of Physical Education at U. S. C. A longtime friend and golfing companion of Butch.

HOFFMAN, BOB—Plant Superintendent of Mercury.

KELLER, WALTER E.—A golf pro, with two golf shops in Los Angeles. A longtime friend and golfing companion of Butch.

KINSEY, ROY HENRY—duPont's expert on the chemistry and marketing of "Surlyn."

LEIGHTON, CHARLES—President of C & G Plastics, a custom injection molder, since 1963. With Mercury from 1945 to 1963.

MCCLURE, DONALD J.—Vice President and Counsel for the Wilson Sporting Goods Division of Pepsico, Inc.

POCKLINGTON, TERRY—Identified by Ram's Vice President, Mr. James R. Hansberger, as "probably the foremost golf ball authority as far as I was concerned at that time and probably still feel the same today, available in the world." Mr. Pocklington was successively Plant Chemist, Director of Research and Development, and Plant Manager for Ram.

POULIN, RAYMOND J.—Sole owner of Ray's Mold Shop in Topanga, California.

RHODES, WILLIAM S.—Owner and President of Mercury.

SPARKENBAUGH, MARIAN—Personal secretary to Mr. Rhodes.

SPEITH, HOWARD E.—A chemist experienced in infrared analysis. Longtime friend and golfing companion of Butch.

TOCKER, EDWIN—A duPont patent lawyer who in 1969 made a partial investigation of the activity of Butch.

WAGNER, ROBERT B., JR.—Son of Bob, grandson of Butch. Executive and Vice President of Western Golf Sales.

WARREN, JUDY—Secretary-bookkeeper to Mr. John B. Knight, a C.P.A. and Vice President of Mercury.